

Applicants: Michael Wayne Graham et al.
Serial No.: 10/821,726
Filed : April 8, 2004
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REMARKS

Claims 34 and 88-132 were pending in the subject application. By this Amendment Applicants have added new claim 133. Accordingly, claims 34 and 88-133 are presented for the Examiner's consideration.

The April 2, 2007 Notice alleged that Applicants' November 30, 2006 Amendment cancels all claims drawn to the elected invention and presented only claims drawn to a non-elected invention. On this basis the Notice alleged Applicants' November 30, 2006 Amendment was non-responsive, citing MPEP §821.03. The specific reasoning provided in the Notice was that the "remaining claims are not readable on the elected invention because the elected invention is a method of a method of delaying, repressing or otherwise reducing the expression of a target gene in an animal cell while the claims as amended are directed to a method of producing an RNA molecule capable of delaying, repressing or otherwise reducing the expression of a target gene and are therefore directed to a method of making an RNA molecule, rather than a method of reducing gene expression."

In response, Applicants respectfully point out that the reasoning provided in the April 2, 2007 Notice is based exclusively on the language of the preamble of the claims, which language is generally not accorded any patentable weight. See, e.g. Examination Guideline of M.P.E.P. §707.07(g):

¶ 7.37.10 *Unpersuasive Argument: Limitation(s) in Preamble*

In response to applicant's arguments, the recitation [1] has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). (Emphasis added.)

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Applicants point out that the body of the pending process claims is a clarified version of the body of the process claims pending at the time the election was made. The body of claim 34 pending at the time the election was made recited "A method ... comprising introducing an RNA nucleic acid molecule ..., wherein the RNA nucleic acid molecule includes a transcription product of a genetic construct comprising ..." which is consistent with the body of the pending method claim as presented in this Amendment. Therefore, the reasoning of the April 2, 2007 Notice does not support the conclusion of the Notice that the pending process claims are drawn to a non-elected invention.

Applicants have also added new claim 133 to show that body of the pending process claims does not depend on the preamble for completeness and that the process steps of the body do stand alone.

Accordingly, the pending process claims recite subject matter consistent with the elected process and examination of the pending process claims should proceed without ado.

Applicants further point out that even if the preamble of the pending process claims was to be accorded patentable weight, a process of delaying, repressing or otherwise reducing the expression of a target gene in a cell according to Applicants' invention does in fact require the production in a cell of an RNA molecule capable of doing so, as recited. Thus, even if the preamble of the pending claims were accorded patentable weight, the pending claims read on the elected invention.

In conclusion, Applicants look forward to the examination of the pending claims.

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No fee, other than the \$1,020.00 for a three-month extension, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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